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Paper No. 11  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Roche Diagnostics Corporation, by change of name from  
Boehringer Mannheim Corporation<sup>1</sup>

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Serial No. 75/593,060

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Andrea Wilson Gregory of Bose McKinney & Evans LLP for  
Roche Diagnostics Corporation, by change of name from  
Boehringer Mannheim Corporation.

Esther A. Belenker, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

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Before Cissel, Seeherman and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 20, 1998, Boehringer Mannheim Corporation,  
(later its name was changed to Roche Diagnostics  
Corporation), filed an application to register the mark D-  
TECTOR on the Principal Register for "medical apparatus,  
namely, an optical screening device for noninvasively

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<sup>1</sup> The records of the Assignment Branch of this Office indicate  
that applicant has undergone a change of name. (Reel 1847, Frame  
0627.)

measuring optic lens fluorescence from glycosylated end products and glycosylated proteins in the eye[s] of individuals potentially having diabetes, primarily for use by optometrists and ophthalmologists" in International Class 10; and "printed instructional materials and brochures relating to diabetes" in International Class 16. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

The Examining Attorney has finally refused registration for both classes of goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the mark D-TECTOR, when applied to the identified goods of the applicant, would be merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The Examining Attorney contends that the mark D-TECTOR is the phonetic equivalent of DETECTOR, which describes the nature and purpose of the goods, which is to detect (and then measure) the amount of optic lens fluorescence in the eye. In her January 31, 2000 Office action (p. 2), the Examining Attorney stated that "[t]he printed materials are used in connection with such detectors." Therefore, the

Board assumes that the refusal to register applies to both classes of goods.<sup>2</sup> However, it is clear from this record that both the Examining Attorney and applicant's attorney focused their arguments and evidence on the medical apparatus, and not the printed instructional materials.

In support of her refusal to register under Section 2(e)(1), the Examining Attorney submitted the following materials: (i) a dictionary definition of the word "detector," and (ii) photocopies of six of the 21 total excerpted stories found from a search [framed as "detector w/20 (diabetes or diabetic)"] of the Nexis database.

Applicant contends that the identified goods are optical screening devices for measuring optic lens fluorescence, and printed instructional materials used therewith; that there is no "detection" involved as these devices do not detect anything, rather they measure optic lens fluorescence; that there is always some level of glucose and optic lens fluorescence present in the eye, and therefore the device does not detect the presence or absence of it, but rather measures the amount of it; that competitors do not use the term "detector" in describing medical diagnostic equipment which measures amounts of some

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<sup>2</sup> Applicant paid the proper fee for an appeal of both classes of goods.

particular chemical or body mass; that the dictionary definition of "detector" relied on by the Examining Attorney is far too broad to render the mark D-TECTOR merely descriptive to the professional purchasers of these specific goods as the mark does not immediately describe any quality, characteristic, feature, etc. of these goods; and that doubt is resolved in applicant's favor.

Applicant submitted three user's manuals for diabetes diagnostic equipment manufactured by three of applicant's competitors.

The well-established test for determining whether a mark is merely descriptive is whether the mark immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must immediately convey information about the goods or services with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, unpub'd, Fed. Cir. February 13, 1991. Whereas, a mark is suggestive if imagination, thought or perception is required to reach a

conclusion on the nature of the goods or services. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

Of course, whether a term or phrase is merely descriptive is determined not in the abstract, but in relation to the specific goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the relevant purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

The burden of establishing a *prima facie* case that applicant's mark is merely descriptive rests with the Examining Attorney. Viewing this record in its entirety, we find that the mark D-TECTOR is not merely descriptive of either the optical scanning device or the printed instructional materials set forth in the application. That is, the evidence of record does not establish that this mark, D-TECTOR, conveys an immediate idea of a primary purpose of applicant's goods.

There is no question that D-TECTOR is the phonetic equivalent of DETECTOR. The American Heritage Dictionary (Third Edition 1992) defines "detector" as "one that detects, especially a mechanical, electrical, or chemical device that automatically identifies and records or registers a stimulus, such as an environmental change in pressure or temperature, an electrical signal, or radiation from radioactive material." The six excepted stories retrieved from the Nexis database and submitted by the Examining Attorney generally relate to literally detecting diseases such as, diabetes, kidney disease and cancer.

Although not raised by the Examining Attorney, we note that perhaps to the general public, the word "detector" is sometimes used to describe something that measures, such as smoke detectors, carbon dioxide detectors, and metal detectors. However, in terms of the medical field, there is no evidence of record that medical apparatus and devices used for measuring are referred to as "detectors." To the contrary, applicant's evidence in the form of brochures from some of applicant's competitors shows that diagnostic equipment used by diabetics (which is obviously not the same medical device involved in this application) is referred to as a monitor or a monitoring system, not a detector.

On this record, we find that there is some doubt as to whether the term D-TECTOR, as the phonetic equivalent of "DETECTOR," is merely descriptive of applicant's optical screening device for measuring optic lens fluorescence. As applicant has explained, optic lens fluorescence is always present in the eye, and applicant's apparatus is not used to detect the fluorescence, but measures how much is present. Because applicant's goods are "primarily for use by optometrists and ophthalmologists," and because there is no evidence that the term "detector" includes measuring devices, we cannot say that the mark has been shown to be merely descriptive of applicant's medical apparatus. Further, there is no evidence relating to D-TECTOR with respect to printed instructional materials.

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992). At the very least, if doubt exists, as we find it does here, as to whether a term is merely descriptive, it is the practice of this Board to resolve that doubt in favor of the applicant and pass the application to publication. See *In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1995); and *In re Gourmet Bakers*

Inc., 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the mark is, in fact, descriptive, may oppose and present evidence on this issue to the Board.<sup>3</sup>

**Decision:** The refusal to register under Section 2(e)(1) is reversed.

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<sup>3</sup> In addition, we note that while this application is based on applicant's assertion of a bona fide intention to use the mark in commerce, there is no evidence to show how applicant plans to use the involved mark on either the medical apparatus or the printed instructional materials. Specifically, there are no specimens of record, and the Examining Attorney did not request under Trademark Rule 2.61(b) any information on applicant's medical apparatus, nor any information regarding its printed instructional materials. If applicant's specimens of use demonstrate descriptive use of this mark, the Examining Attorney may wish to re-examine the application with respect to the issue of mere descriptiveness.